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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/800,826	03/08/2001	Alex Nadezhdin	AML/11665.33	3651

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CANADA

EXAMINER

CHEVALIER, ALICIA ANN

ART UNIT	PAPER NUMBER
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1772

DATE MAILED: 04/07/2003

10

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/800,826

Applicant(s)

NADEZH DIN ET AL.

Examiner

Alicia Chevalier

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 23 January 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-22 and 37-39 is/are pending in the application.
- 4a) Of the above claim(s) 7-9, 12-22 and 38 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-6, 10, 37 and 39 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_ 6) ☐ Other: \_\_\_\_\_

## **RESPONSE TO AMENDMENT**

### ***WITHDRAWN REJECTIONS***

1. The objection to claim 1 of record in paper #8, page 2, paragraph #6 has been withdrawn due to Applicant's amendment in paper #9.

### ***REJECTIONS REPEATED***

2. The 35 U.S.C. §103 rejections of claims 1-6, 10 and 37 are repeated for reasons previously of record in paper #8, pages 2-4, paragraphs #4-6.
3. Claims 1, 4, 5, and 37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Winter, IV (5,224,315) in view of Spively (6,173,540).

Winter discloses a prefabricated building panel comprising an inner skin layer, a multi-layered core, and an outer skin layer (figure 1). The inner and outer skin layers may comprise oriented strand board (col. 6, lines 24-31). The middle layer of the multi-layers core comprises a paper honeycomb (perforated mat) (col. 8, lines 17-21), which has voids having boundaries that are essentially orthogonal to the skin layers. Selection of the relative voids by volume in the broad ranges claimed is taken as being within the ordinary skill of the art absent unexpected results.

The prefabricated building panel is used for wall, roof, and floor paneling (col. 1, lines 16-17).

Winter fails to disclose the composition of the oriented strand board.

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Spivey discloses an oriented strand board used for a stair tread panel comprising a cut wood strips mixed in a phenolic resin (col. 2, lines 45-59).

It would have been obvious to one of ordinary skill in the art at the time of the invention to use the oriented strand board of Spivey as the oriented strand board of Winter. One of ordinary skill would have been motivated to do so in order to give Winter's paneling a wood appearance.

Furthermore, since the combination of Winter and Spively discloses all the limitations of claim 1, the core would be capable of being compression-resistant in a direction essentially orthogonal to said plane defined by said first oriented strand face.

4. Claims 2 and 3 are rejected under 35 U.S.C. 103(a) as being unpatentable over Winter, IV (5,224,315) in view of Spively (6,173,540) as applied to claims 1, 4, 5, and 37 above, and further in view of Medawar (3,815,215).

The combination of Winter and Spively disclose all the limitation of the instant claimed invention except for the core comprising an inorganic filler.

Medawar discloses a honeycomb structural panel for walls, etc. The structural panel comprises two skin layers sandwiched around a honeycomb core (figure 1). The honeycomb layer is filled with a filler material comprising a mixture of an epoxy resin and calcium carbonate (col. 4, lines 14-19) to prevent lateral distortion and column failure (col. 2, lines 22-23).

Selection of the relative weight percent of inorganic filler in the broad ranges claimed is taken as being within the ordinary skill of the art absent unexpected results

It would have been obvious to one of ordinary skill in the art at the time of the invention to add the filler material of Medawar to the honeycomb layer of Winter. One of ordinary skill

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would have been motivated to add the filler material to Winter in order to help prevent lateral distortion and/or column failure.

5. Claims 6 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Winter, IV (5,224,315) in view of Spively (6,173,540) as applied to claims 1, 4, 5, and 37 above, and further in view of Haywood (3,895,997).

The combination of Winter and Spively disclose all the limitation of the instant claimed invention except for the core made of paper mill sludge.

Haywood discloses recycling paper mill sludge (paper waste) to be useful in different types of paneling boards, see whole document.

It would have been obvious to one of ordinary skill in the art at the time of the invention to use paper mill sludge as taught by Haywood to make the paper honeycomb core of Winter. One of ordinary skill would be motivated to use the paper mill sludge as the paper material of Winter's honeycomb because using recycled material would be cheaper.

#### ***NEW REJECTIONS***

6. **The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.**

#### ***Claim Rejections - 35 USC § 103***

7. Claim 39 is rejected under 35 U.S.C. 103(a) as being unpatentable over Winter, IV (5,224,315) in view of Spively (6,173,540).

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Winter discloses a prefabricated building panel comprising an inner skin layer, a multi-layered core, and an outer skin layer (figure 1). The inner and outer skin layers may comprise oriented strand board (col. 6, lines 24-31). The middle layer of the multi-layers core comprises a paper honeycomb (perforated mat) (col. 8, lines 17-21), which has voids having boundaries that are essentially orthogonal to the skin layers. Selection of the relative voids by volume in the broad ranges claimed is taken as being within the ordinary skill of the art absent unexpected results.

The prefabricated building panel is used for wall, roof, and floor paneling (col. 1, lines 16-17).

Winter fails to disclose the composition of the oriented strand board.

Spivey discloses an oriented strand board used for a stair tread panel comprising a cut wood strips mixed in a phenolic resin (col. 2, lines 45-59).

It would have been obvious to one of ordinary skill in the art at the time of the invention to use the oriented strand board of Spivey as the oriented strand board of Winter. One of ordinary skill would have been motivated to do so in order to give Winter's paneling a wood appearance.

Furthermore, since the combination of Winter and Spively discloses all the limitations of claim 1, the core would be capable of being compression-resistant in a direction essentially orthogonal to said plane defined by said first oriented strand face.

The phrase "able to" is considered to be equivalent to "capable of." It has been held that the recitation that an element is "capable of" performing a function is not a positive limitation but only requires the ability to so perform. Therefore, in addition to the above disclosed

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limitations, the presently claimed properties (i.e. able to resist at least about 12Mpa of pressure ...) would have necessarily been present because the combination of Winter and Spively disclose all the limitation of the instant invention, and there is no evidence currently of record showing that the disclosed prior art products do not necessarily possess the characteristics of the claimed product.

### ***ANSWERS TO APPLICANT'S ARGUMENTS***

8. Applicant's arguments filed in paper #9 regarding the 35 U.S.C. 103 over Winter, IV (5,224,315) in view of Spively (6,173,540) have been carefully considered but are deemed unpersuasive.

In response to Applicant's argument that Winter is not directed to a wood panel comprising a core layer with properties aimed at supporting the outer face thereby providing resistance to compression during the press cycle and that Winter clearly does not teach the use of a compression-resistant core. The fact that Applicant uses the oriented strand board composite structure for a different purpose does not alter the conclusion that its use in a prior art device would be prima facie obvious from the purpose discloses in the reference. Furthermore, since the combination of Winter and Spively discloses all the limitations of claim 1, the core would be capable of being compression-resistant in a direction essentially orthogonal to said plane defined by said first oriented strand face.

Applicant's argues that Spivey has no relevance. The Examiner disagrees because Spivey discloses an oriented strand board for use in construction which is a similar endeavor of

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Winter and Applicant's instant invention. Applicant has failed to clearly point out the supposed errors with the motivation to combine Winter and Spivey.

9. Applicant's arguments filed in paper #9 regarding the 35 U.S.C. 103 over Winter, IV (5,224,315) in view of Spively (6,173,540) and further in view of Medawar (3,815,215) have been carefully considered but are deemed unpersuasive.

Applicant's arguments regarding the Winter reference have already been addressed above.

Applicant argues that Medawar is used to fill the void space in the core and the present invention uses the inorganic filler is added to the material used to form the core. The limitations on which the Applicant relies (i.e. filler is added to the material used to form the core) are not stated in the claims. It is the claims that define the claimed invention, and it is claims, not specifications that are anticipated or unpatentable. Claim 2 merely recites that the "core further comprises inorganic filler" and is absent about whether the filler is in material used to manufacture the core or used to fill the voids. The claim language is broad enough to read on either scenario. Furthermore, the fact that Applicant does not desire to fill the voids does not alter the conclusion that a prior art device would be prima facie obvious because Applicant's arguments are not commensurate in scope with the broad claim language.

10. Applicant's arguments filed in paper #9 regarding the 35 U.S.C. 103 over Winter, IV (5,224,315) in view of Spively (6,173,540) and further in view of Haywood (3,895,997) have been carefully considered but are deemed unpersuasive.

Applicant's arguments regarding the Winter reference have already been addressed above.



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Applicant argues that there is no mention is made in Haywood of using boards fabricated according to the disclose as the core of an oriented strand board composite. The Haywood reference is only used to show recycling paper mill sludge (paper waste) is useful in different types of paneling boards. Since paper mill sludge is useful in different types of paneling boards, it would have been obvious to one of ordinary skill in the art at the time of the invention to use paper mill sludge as taught by Haywood to make the paper honeycomb core of Winter. One of ordinary skill would be motivated to use the paper mill sludge as the paper material of Winter's honeycomb because using recycled material would be cheaper.

### ***Conclusion***

11. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

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12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alicia Chevalier whose telephone number is (703) 305-1139.

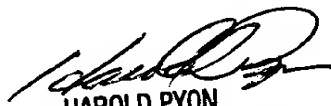
The Examiner can normally be reached on Monday through Thursday from 8:00 a.m. to 5:00 p.m. The Examiner can also be reached on alternate Fridays

If attempts to reach the Examiner are unsuccessful, the Examiner's supervisor, Harold Pyon can be reached by dialing (703) 308-4251. The fax phone number for the organization official non-final papers is (703) 872-9310. The fax number for after final papers is (703) 872-9311.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose phone number is (703) 308-0661.

ac

3/28/03

  
HAROLD PYON  
SUPERVISORY PATENT EXAMINER  
1772

4/3/03